



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

*MM*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,189	12/15/2003	Berndt P. Schmit	07778.002 / 6096 P	4384

7590 05/25/2004

Vanessa B. Pierce  
Parsons Behle & Latimer  
Suite 1800  
201 S. Main St.  
Salt Lake City, UT 84111-2218

EXAMINER


CHANG, CHING

ART UNIT	PAPER NUMBER
----------	--------------

3748

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/736,189	<b>Applicant(s)</b> SCHMIT ET AL. 	
	<b>Examiner</b> Ching Chang	<b>Art Unit</b> 3748	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-20 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-15 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/15/2003</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Objections*

1. Claims 4, and 16-20 are objected to because of the following informalities:
  - "inner tubing " in claims 4 and 16 appears to be -- an inner tubing --.
  - " the at least one valve with one end of at least one of the at least one one valves in the inner space " in claim 16 appears to be -- the at least one valve with one end in the inner space --.

Appropriate corrections are required.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 3748

**2(a). *Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of Schmit et al. (U.S. Patent No. 6,684,096).***

Although the claims are not identical, they are not patentably distinct from each other because the claim of the instant application is substantially the same as that claimed in the US '096 Patent; however, the scope of claim 1 in this instant application lacks of the castable sleeve having an inner space between the proximal and distal layers, the inner space being capable of receiving a quick cast material, at least one valve in the castable sleeve for introduction of quick cast material, wherein an inner tubing is connected to the at least one valve and includes dispersion holes that permit the quick cast material to be optimally dispersed throughout the castable sleeve, and thus is broader than that of claim 1 in the US '096 Patent.

**2(b). *Claim 10 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of Schmit et al. (U.S. Patent No. 6,684,096).***

Although the claims are not identical, they are not patentably distinct from each other because the claim of the instant application is substantially the same as that claimed in the US '096 Patent; however, the scope of claim 10 in this instant application lacks of the castable sleeve having at least one valve for introduction of the quick cast material, wherein an inner tubing is connected to the at least one valve and includes

dispersion holes that permit the quick cast material to be optimally dispersed throughout the castable sleeve, and thus is broader than that of claim 2 in the US '096 Patent.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. ***Claims 1, 6, and 8-9 are rejected under 35 U.S.C. 102(b) as anticipated by Marandos (US Patent No. 5,400,787).***

Marandos discloses an apparatus (10) for stabilizing and restraining a limb of a patient in an imaging device (24), the apparatus comprising: a castable sleeve (14), the castable sleeve comprising a proximal layer and a distal layer, the proximal layer contacting at least a portion of the patient's limb (See Fig. 2); and an expandable sleeve (12) surrounding the distal layer of the castable sleeve; wherein the expandable sleeve includes at least one valve for introduction of an expandable material therein (See Fig. 1); further comprising at least one subchamber within the castable sleeve (See 3, line 25 through line 36); further comprising at least one subchamber within the expandable sleeve (See Col. 2, line 57 through line 65).

Art Unit: 3748

5. ***Claims 10-11 are rejected under 35 U.S.C. 102(b) as anticipated by Filler et al. (US Patent No. 5,560,360).***

Filler discloses an apparatus (58, 156) for stabilizing and restraining a patient (See Fig. 8) in an imaging device (14), the apparatus comprising a castable sleeve (164), the castable sleeve comprising a proximal layer and a distal layer, the proximal layer contacting at least a portion of the patient's body (See Fig. 24), wherein the castable sleeve has an inner space between the proximal and distal layers, the inner space in fluid communication with a quick cast material (See Fig. 19); further comprising an expandable sleeve (See Col. 25, line 38 through line 42), wherein the expandable sleeve comprises concentric layers of fluid impermeable material; further comprising at least one subchamber within the expandable sleeve.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3748

7. ***Claims 2-3, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marandos (as applied to claims 1 above) in view of Filler (US Patent No. 5,560,360).***

Marandos discloses the invention, however, fails to disclose a quick cast material being used in the castable sleeve.

The patent to Filler on the other hand, teaches that it is conventional in the art of a filling material being used in a medical device, to utilize gel or foam (See Col. 25, line 29 through line 42) in a sleeve (164) of a limb restraining device, via a pressure regulated delivery system, and two such sleeves can be used in one operation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the sleeves filled with gel or foam as taught by Filler in the Marandos device, since the use thereof would provide an alternative and comfort limb restraining apparatus for a medical, imaging device.

8. ***Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marandos (as applied to claim 1 above) in view of Arkans (WO' 727).***

Marandos discloses the invention, however, fails to disclose a rip cord being aiding the removal of the limb restraining apparatus.

The patent to Filler on the other hand, teaches that it is conventional in the art of removing aid for a limb restraining apparatus, to utilize a rip cord (26) to aid the removal of a limb restraining apparatus.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the rip cord as taught by Arkans in the Marandos device, since the use thereof would provide an improved limb restraining apparatus.

9. ***Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Filler (as applied to claims 11/10 above) in view of Marandos (US Patent No. 5,400,787).***

Filler discloses the invention, however, fails to disclose air being introduced through a valve into the expandable sleeve.

The patent to Marandos on the other hand, teaches that it is conventional in the art of a limb restraining device, to utilize air through a valve (Fig. 1) into a expandable sleeve (12).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have utilized the air through a valve into a expandable sleeve as taught by Marandos in the Filler device, since the use thereof would provide an alternative and comfort limb retraining device for a medical, imaging device.

***Allowable Subject Matter***

10. Claims 16-20 are allowed.



11. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ching Chang whose telephone number is (703)306-3478. The examiner can normally be reached on M-Th, 7:00 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Denion can be reached on (703)308-2623. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 10/736,189

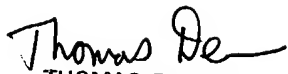
Page 9

Art Unit: 3748

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Ching Chang

  
THOMAS DENION  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700